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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/962,271 10/31/97 FREEMAN

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EXAMINER

FOSTER, J  
ART UNIT PAPER NUMBER

3728  
**DATE MAILED:**

#23

01/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. <b>08/962,271</b>	Applicant(s) <b>Freeman et al.</b>
Examiner <b>J. Foster</b>	Group Art Unit <b>3728</b>

Responsive to communication(s) filed on Nov 6, 2000.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-51 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1-12, 20-22, and 49 is/are allowed.

Claim(s) 13, 15-17, 19, 23-48, 50, and 51 is/are rejected.

Claim(s) 14 and 18 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1-12, 20-22 and 49 are allowable over the prior art of record.

2. Claims 23-48 are finally rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. See MPEP 1412.02.

To attempt to achieve allowance on April 27, 1995, claim 15 of the original application, which became patent claim 16, was amended by Applicant to add, a limitation, "a releasable seal adapted to seal said compartment and maintain", with the term "maintain" referring to the already existent limitation,

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"...said electrode in a sealed mode". Applicant also added a limitation that a barrier element was positioned at the releasable seal. The claim had not previously included a limitation regarding a releasable seal. Reissue claims 23-48 are missing this limitation with respect to a releasable seal. The reissue claims 23-48 are also missing the limitation with respect to the barrier element being positioned at the releasable seal.

Inasmuch as the limitations that are missing in claims 23-28 are ones Applicant had relied upon for allowance of said claim 15, it is asserted that Applicant is now trying to improperly recapture subject matter that Applicant had surrendered to achieve the allowance.

3. In Applicant's response filed on November 6, 2000, Applicant amended claim 23 to structurally call for the electrode to be contained by the compartment and for the electrode to be maintained in isolation from the external environment. Therefore, regarding this aspect, claim 23 is no longer being broadened over replaced original claim 15 of the parent application.

In addition, claim 23 is no longer considered to be broadened with respect to the omission of the limitation, "the connector being exposed to the external environment" since claim 23 otherwise calls for the connector to provide an electrically conductive path to the electrode from the outside.

Accordingly, the narrowing with respect to the connector providing a conductive path to the electrode from the outside

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modifies the claim such that the scope of the claim no longer results in a recapture of surrendered subject matter. See MPEP 1412.02, REISSUE CLAIMS ARE BROADER IN SCOPE IN SOME ASPECTS, BUT NARROWER IN OTHERS.

However, Applicant's argument that the narrowing of some limitations in claim 23 has negated recapture, is not persuasive. The narrowing of limitations regarding a connector does not overcome the recapture that exists with respect to the releasable seal or the location of the barrier element at the releasable seal. Connectors are means to conduct electricity and are not related to releasable seals which refer to heat seals that are weak enough to be opened under force. While a connector might be somewhat related to a barrier element, claim 23 fails to call for the location of a connector to be at a releasable seal.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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5. Claims 13, 15, 16, 19, 23, 24 and 46 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Engel (4,539,996). In the reference of Engel, an electrode is provided at 18, and a package is defined by the combination of backing 20, strip 24 and release liner 26. The release liner is releasably adhesively attached at least to the strip 24 (see Fig. 2). Connected to the electrode 18 is an electrically conductive path/connector 16. A portion of the element 16 located under the barrier element/strip 24 may be considered to be a connector body portion of the barrier element. The portion of the connector 16 that is exterior to the strip 24 reasonably defines a terminal since a definition for "terminal" is a *terminating point, limit or part.* Said terminal portion of connector 16 would inherently be capable of making or breaking an electrical connection with a complementary terminal, such as a wire-attached metal terminal that has a cavity for receiving and electrically engaging the end of the connector 16, or a such as wire-attached alligator clip, or such as the clip referred to in column 5, lines 8-10 of Engel.

Regarding a second compartment, the area between the unnumbered tabs of the backing 20, which extend beyond the strip 24, may be considered to define a second compartment within which the terminal end of the connector 16 resides, insofar as Applicant has claimed.

6. Claims 23-28, 45, 48 and 51 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Gilman et al (5,402,884).

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In the reference of Gilman et al, a package is provided at 99,100, and defibrillator electrodes are provided at 128,129. The periphery of the package provides a barrier element. Extending from within the compartment of the package through the periphery of the package to the exterior environment are connectors/ connective paths/connector bodies defined by wire leads 132,135. The portions of the connector bodies which extend through the package periphery/barrier element may be considered to be a part of the barrier element. The portions exterior to the periphery may be considered to define connectors or terminals. Since wire leads are capable of being stripped for removable connection, e.g., by attachment of an electrical clip, the connector bodies 132,135 of Gilman et al are inherently capable of making or breaking an electrical connection. Inasmuch as the wire conductors and insulators of the connector bodies are round in cross section, they provide arcuate (i.e., semicircular) top and bottom portions of the connector body which are engaged by top (100) and bottom (99) walls of the package compartment.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 16, 17, 19, 43 and 44 are finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilman et al (5,402,884) in view of Engel (4,539,996). Although the reference of Gilman et al does not disclose how the electrode packages are opened, the reference of Engel (col. 5 lines 47-50) suggests that top and bottom walls of an electrode package may be releasably sealed in order to permit opening of the package. Accordingly, it would have been obvious in view of Engel to have made the sealed periphery of Gilman et al with a releasable seal, for the purpose of opening the package.

Although the reference of Gilman et al does not disclose sealing the top and bottom walls of the package to the upper and lower surfaces of the connector bodies 132,135, the reference of Engel (col. 5, lines 38-46; Fig. 2) suggests adhesively attaching a connector body (16) to between upper and lower walls (24,20) in an electrode package. Such adhesive attachment would inherently complete the seal of the electrode within the package. Therefore, it would have been obvious in view of Engel at 24,25 to have provided a sealing attachment between the connectors 132,135 of Gilman et al and the top and bottom walls 100,99, for the purpose of completely sealing the package.

9. Claim 50 is finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Engel (4,539,996) in view of Gilman et al (5,402,884). Although the reference of Engel does not disclose a defibrillator electrode, the reference of Gilman et al suggest providing a package for a defibrillator electrode for storing it prior to use. Accordingly, it would have been

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obvious in view of Gilman et al to have packaged as the electrode 12,18 a defibrillator electrode, for the purpose of storing it prior to use.

10. Claims 14 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 29-42 and 47 distinguish over the prior art. However, indication of patentable subject matter in these claims has been withheld in view of rejection under 35 U.S.C. 251 set forth in paragraph 2.

12. Applicant's arguments filed November 6, 2000 have been fully considered but they are not persuasive. The answer to Applicant's arguments, regarding there being no improper recapture, is set forth in paragraphs 3 above

In addition, Applicant's arguments with respect to the prior art rejections are considered by the examiner to be substantially a repetition of arguments that Applicant has made earlier in the prosecution, for example in the papers filed on Feb 22, 1999 and September 30, 1999. These arguments have already been rebutted by the examiner, in the Office actions mailed May 25, 1999 and May 30, 2000.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. To insure prompt handling of correspondence after final rejection, it should be addressed **BOX AF**. For contacting the PTO by phone, the following contact numbers may be used:

For tracking of papers and association of papers with cases --

Customer Service. . . (703)306-5648

For matters regarding examination -- Examiner:

Jim Foster . . . . (703)308-1505

For faxing of correspondence:

Draft amendments only-(703)308-7769

(Examiner should be notified of fax)

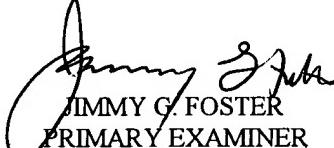
Formal correspondence-(703)305-3579 or 305-3580

For any petitions:

Before the Examiner . (703)308-1505

Before the Director . (703)308-3872

Other petitions . . . (703)305-9282

  
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PRIMARY EXAMINER  
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1/23/01

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January 23, 2001